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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,715	10/22/2003	Robert E. Burrell	14072-037001 / W 618	9773
26161	7590	07/25/2006	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			PAK, JOHN D	
			ART UNIT	PAPER NUMBER

1616

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/690,715

Applicant(s)

BURRELL ET AL.

Examiner

JOHN PAK

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 34-60 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 40-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 34-39 and 58-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/04, 5/04, 6/04, 7/04, 3/05, 6/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Claims 1-6 and 34-60 are pending in this application.

Applicant's election with traverse of the invention of Group II (silver-containing material is not atomically disordered silver, see previous Office action for full details) in the response filed on 5/2/2006 is acknowledged. Applicant argues that a genus/species may be appropriate for claims 1-6 but said claims should not be restricted into two different groups. The Examiner cannot agree for the reasons of record. Both distinctness and undue burden requirements of a proper restriction requirement are met by the two invention group, as set forth in the previous Office action (3/22/2006). As such, the restriction between the invention groups is not improper.

Claims 1-5 are generic to the following disclosed patentably distinct species: silver-containing materials such as silver nitrate, colloidal silver, silver lactate. The species are independent or distinct because they contain substantially divergent anions in the case of the nitrate/lactate or form in the case of colloidal silver. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

During a telephone conversation between the Examiner and Mr. Daley on 7/11/2006, Mr. Daley elected with traverse silver nitrate as the single disclosed species of the silver-containing material.

It is noted that claim 6 does not recite silver nitrate as a species: only silver nitrate + silver sulfadiazine mixture is recited. Claim 6 therefore do not read on the elected subject matter. Claims 40-57 also do not read on the elected subject matter. Hence, claims 6 and 40-57 are withdrawn from further consideration as being directed to non-elected subject matter. Claims 1-5, 34-39 and 58-60 will presently be examined to the extent that they read on the elected subject matter of record.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 34-36, 38-39, 58-60 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 2000327578 (submitted by applicant in the IDS of 3/17/2004, reference AVVVV and its English abstract, WWWW).

JP 2000327578 explicitly discloses a silver emulsion composition for medicinal purposes (see abstract). The following components are mixed:

30 cc distilled water + 1 g silver nitrate;

0.3 to 1.2 cc saturated  $\text{NaHCO}_3$  aqueous solution; and

0.1 to 0.5 cc saturated  $\text{MgO}$  aqueous solution.

The resulting mixture would contain silver nitrate in the approximate range of about 3 wt%, depending on the precise quantity of other ingredients. The resulting mixture thereby anticipates applicant's claims 1-5, 34-36, 38-39 and 58-60.

It is noted in this regard that applicant claims benefit of the earlier filing date of 09/628,735 (7/27/2000), which would predate this reference. However, the instant claims cannot be afforded that earlier effective filing date because 09/628,735 only disclosed nanocrystalline form of silver or silver compounds, whereas the instant claims are directed to any silver-containing material without the nanocrystalline limitation.

Claims 1-5, 34-35, 38-39, 58-60 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 328,421.

EP 328,421 explicitly discloses a coating composition for medical devices such as catheters that contains 1% silver nitrate, 1-3% chlorhexidine, and a polyurethane mixture (page 13, lines 21-30).

The Examiner finds a coating composition for medical devices to fall within the ambit of "pharmaceutical composition" since the term "pharmaceutical" is broad enough to encompass delivery of antimicrobial activity to a device that is being used for medical or surgical purposes -- see also applicant's disclosure of substrate coating feature in the instant specification, starting on page 30. Further, the Examiner finds the coating composition of the cited reference to fall within applicant's solutions or paste (claim 58).

The claims are thereby anticipated.

Claims 1-5, 34-39 and 58-60 are rejected under 35 U.S.C. 102(b) as being anticipated by HU 9800078 (submitted by applicant in the IDS of 3/17/2004, ref AGGGGG).

HU 9800078 explicitly discloses a pharmaceutical composition that contains an ethanolic or aqueous solution of iodine and 2-20 wt% silver nitrate. The claims are thereby anticipated.

For these reasons, all claims must be rejected at this time.

Art Unit: 1616


Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Johann Richter, can be reached on **(571)272-0646**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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